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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/076,337	02/15/2002	Robert Wilmes	40655.3700	2479

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EXAMINER

O'CONNOR, GERALD J

ART UNIT PAPER NUMBER

3627

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/076,337

Applicant(s)

Wilmes et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on August 17, 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 and 26-36 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 26-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on February 15, 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20020215
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of the invention of Group I, claims 1-14 and 26-36, in the reply filed August 17, 2005 is hereby acknowledged.
2. The cancellation of non-elected claims 15-25 by applicant in the reply filed August 17, 2005 is hereby acknowledged.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the examiner has cited the references on form PTO-892, they have not been considered.

### ***Specification***

4. The disclosure is objected to because it contains embedded hyperlinks and/or other forms of browser-executable code. Applicant is required to delete all such embedded hyperlinks and/or other forms of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 112, First Paragraph***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose, in an adequately enabling manner, how the “VoIP” embodiment would function (enable voice transmissions via a digital computer data network), nor does the specification adequately disclose how the invention would be practiced by means of voice communication rather than data communication (i.e., such that it could be performed using an ordinary voice telephone).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-14 and 26-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Sullivan (US 2003/0093320).

Sullivan discloses a transaction tax settlement system comprising: a personal communication device configured to participate in a transaction; a tax information system; and a communication network providing two-way communication between said personal communication device and said tax information system, and said tax information system comprising: a tax directory having a plurality of tax authorities stored thereon, said tax directory configured to facilitate identification of said tax authorities capable of imposing a tax on said transaction; and a tax authority calculation corresponding to each of said tax authorities, said tax authority calculation configured to facilitate determination of a tax rate on said transaction.

Regarding claims 2, 27, and 35, tax information system of Sullivan further comprises an authorization authority configured to validate a payment modality.

Regarding claim 3, in the system of Sullivan, the tax directory identifies said tax authorities upon receipt of a request, said request including a factor of said transaction.

Regarding claim 4, in the system of Sullivan, the factor comprises at least one of a location data, a description of the transaction, or a tax status of a party participating in said transaction.

Regarding claim 5, in the system of Sullivan, the personal communication device submits a request to said tax information system and said request includes factors pertaining to said transaction.

Regarding claim 6, in the system of Sullivan, the tax directory receives said request and returns to said personal communication device information on each of said identified tax authorities capable of imposing a tax on said transaction.

Regarding claim 7, in the system of Sullivan, the returned information includes a location of each of said identified tax authorities.

Regarding claim 8, in the system of Sullivan, the returned information includes a domain name for each of said identified tax authorities.

Regarding claim 9, in the system of Sullivan, the returned information includes a URI of each of said identified tax authorities.

Regarding claim 10, in the system of Sullivan, the tax information system returns to said personal communication device a location of a tax authority calculation.

Regarding claim 11, in the system of Sullivan, the location includes a domain name of a tax authority calculation.

Regarding claim 12, in the system of Sullivan, the location includes a URI of a tax authority calculation.

Regarding claim 13, in the system of Sullivan, the tax rate comprises one of a monetary value, a tax table or a rule.

Regarding claims 14, 29, and 36, in the system of Sullivan, the factor comprises a location data received from at least one of a seller's point of presence, said personal communication device, or a participating third party.

Regarding claim 28, in the system of Sullivan, the transaction data comprises a tax status of said buyer.

Regarding claim 31, the system of Sullivan further comprises a location identification system configured to identify a location of said mobile communication device.

Regarding claim 32, in the system of Sullivan, the location identification system comprises a spatial location and a positional location.

Regarding claim 33, in the system of Sullivan, the telecommunication service provider comprises an Internet Service Provider (ISP) and said mobile communication device configured in a Voice-over-Internet (VOIP) communication (see, in particular, ¶ 126 and ¶ 131).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to the disclosure.

10. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

October 28, 2005



Gerald J. O'Connor  
Primary Examiner  
Group Art Unit 3627

10/28/05